



APPENDIX.

Like other courts, the Supreme Court speaks through decrees, judgments and orders. Reasons underlying its pronouncements are found in its opinions. We shall here briefly consider its decisions in patent cases beginning with the October Term 1931 (Vol. 284 U. S.). We have not counted as separate cases those in which the Supreme Court simultaneously disposed of certiorari to two different Circuits in respect to the same patent or patents. We have not included those cases which consider the relationship of the patent monopoly to anti-trust laws.

The number of cases given hereinafter cannot be completely reconciled because in some instances more than one patent was involved and each received a different treatment.

During the ten years covered, this Court decided fifty-four strictly patent cases. Six cases in which the question of invention was the heart of the decision and two in which the determining issue was aggregation are first here briefly treated. The remaining ones are thereafter more summarily covered.

Patents Held Void for Want of Invention.

1. *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477; March 4, 1935; Justice Stone. The patent involved the use of a flywheel for the recording and reproduction of linear sound records. The claims were held invalid for want of invention as distinguished from mechanical skill. A flywheel for speed constancy was not only old generally, but had been used for this purpose in the reproduction of disc and cylinder records. The

Court cited *inter alia*, *Hailes v. VanWormer*, 20 Wall. 353; decided in 1873.

2. *Essex Razor Blade Corp. v. Gillette*, 299 U. S. 94; November 9, 1936; Justice Roberts. Claims on a razor blade were held void for want of invention, the Court saying:

“The choice (of means to hold the blade in position relative to the cap and guard of the razor) was one between alternative means obvious to any mechanic.”

3. *Mantle Lamp v. Aluminum Co.*, 301 U. S. 544; May 24, 1937; Justice Roberts. The Blair patent for heat insulated receptacle was held invalid for want of invention, all of the elements being old, and only mechanical skill being necessary to combine them.

4. *Honolulu Oil Co. v. Halliburton*, 306 U. S. 550; April 17, 1939; Justice Butler. Except for a difference in a valve, everything disclosed in the patent in suit was old in a prior patent. This prior patentee used a leaky valve for one purpose, and the patentee a tight valve for another. This was not invention.

5. *Standard Brands v. National Grain Yeast Corp.*, 308 U. S. 34; November 6, 1939; Justice McReynolds. Three patents on yeast nutrients were involved; the first was held invalid for want of disclosure. Following the Circuit Court of Appeals, the second patent was held invalid for want of invention, almost without discussion. The third patent was described as a union of two invalid patents, which could not make one good one.

6. *Cuno Engineering Corp. v. Automatic Devices*, 86 Law Ed. Advance Sheets 21; November 10, 1941; Justice Douglas. It was held not to be invention to take an old thermostat used commonly on switches and various kinds of electrical equipment and add it to an old wireless cigarette lighter. The Court cited *Hotchkiss v. Greenwood*, 11 How. 248, decided in 1851.

Patents Held Void on the Ground of Aggregation.

1. *Keystone Driller Co. v. Northwest Engineering Corp.*, 294 U. S. 42; January 7, 1935; Justice Roberts. The Downey patent in suit was held invalid because each of the elements was old and the combination was an aggregation.

2. *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350; May 29, 1939; Justice Butler. The patent was for a torch and perforated cap to cover the flame. It was held invalid because the aggregation of the two old elements which were combined were productive of no new joint function. Cited were *Hailes v. VanWormer*, 20 Wall. 353 and *Hollister v. Benedict*, 113 U. S. 59.

In not one of these cases can there be found any departure from long established principles. The cases cited in these opinions are apt in each instance and come from the years beginning a century ago. In none can we find any justification for the observation that there is shown an "increasing disposition to raise the standards of invention for a patent," or any new doctrinal trend.

It is thought that Justice Frank's observation in the case at bar (R. 1054) is apt and sound:

"In other words, it is highly likely that only an infinitesimal percentage of so-called inventions will be patentable under Judge Hand's test, if informedly applied."

Certainly, under such test, the after-the-fact, very simple invention of Alexander Graham Bell would have been held void for lack of invention (*Telephone Cases*, 126 U. S. 1, 1887). The Morse patent, in which the inventor put two old devices together in making the telegraph, would have also failed for lack of invention (*O'Reilly v. Morse*, 15 How. 62). The same could be said of Eli Whitney's cotton gin, the Barbed Wire patent and the Vacuum Tube, which

is the heart of long distance telephony, in the modern sense, of the movietone industry, and of radio. In very broad meaning, necessity is the mother of invention but, as pointed out by this Court in *Paramount Corp. v. Tri-Ergon Corp.*, 294 U. S. 464, 1935, sound moving pictures created their own demand. It can be equally well said that radio created its own demand, as did the sewing machine, the heart of which was Howe's invention of placing a hole in the needle near its point instead of at its head. To vastly multiply examples of this sort (as might be done) is here unnecessary. If this new doctrine of the Court of Appeals in the case at bar is to prevail, on the assertion that this Court gave it birth, it means that competition by inventors to outrace other inventors in the main will no longer exist; that capital will not venture in the promotion of important new discoveries; that the powerful urge to improve will disappear; and that the many strong virtues of our patent system—and indeed the system itself—will be practically destroyed.

There are numbers of patent cases in which the final question for a court's determination has been whether or not "invention" inheres in the patent. It is usually an easy question to ask, and often a difficult one to answer. In this respect, however, the question of whether the improvement is the product of mere mechanical skill, or is the product of inventive thought, is no more difficult than the question of what is reasonable conduct in a tort case, or reasonable time of delivery in a contract case, or reasonable action in self-defense in a criminal case; and so on throughout the entire field of the law.

Seldom is the science of the law an exact one. Almost invariably the faculty of judgment must be exercised in respect to facts. Pertinent facts in respect to the inherence of invention in a patent are of many different sorts. For instance, what has been the public's judgment of it;

what has been the judgment of competitors; was there in fact a contribution not obvious to one of ordinary skill; had others been seeking without finding; was there a need that those of ordinary skill in the art failed to meet; did the new contribution supplant what had gone before, and did it cure an existing deficiency. Such facts and many other facts of broadly similar nature provide the material upon which the judgment is to be exercised. Of course, there can no more be a definite, mathematical rule to fit all facts than there can be a rule by which one can measure with exactitude the differences between gross negligence, ordinary negligence, and slight negligence in causes where such distinctions are pertinent. Always, however, there are principles to guide one's use of facts in proceeding to the answer. Facts may emerge from confusion; principles cannot thus dwell.

During the ten years beginning with the October Term 1931, there were fifty-four decisions rendered by the Supreme Court in strictly patent cases—an average of substantially five a year. In the footnote below we have listed the names of the Justices writing the Court's opinion and the number of opinions by each.*

The cases decided involved the following issues:

Insufficiency of disclosure.....	3
Accounting problems	4
Jurisdiction, allied questions, and questions of practice	9
Questions of title.....	2
Contributory infringement by furnishing unpatented element	3
Equitable relief withheld because of suppression of evidence	1

Justice Hughes	2	Justice Butler	8
Justice Brandeis	2	Justice Roberts	13
Justice Cardozo	4	Justice Stone	13
Justice McReynolds	4	Justice Reed	1
Justice Jackson	1	Justice Douglas	1
Justice Murphy	1	Justice Black	1

Time of filing divisional application.....	1
Priority of invention between intervening applicants	1
Exhausted combination	1
Infringement by purchaser from restricted licensee	1
Amendment not within original contemplation.....	1
Infringement only issue.....	1
File wrapper estoppel.....	2
Reissue questions	1
Intervening rights	1
Patents held void for anticipation.....	6
Patents held void for want of invention.....	6
Patents held void for aggregation.....	2
Patents held void because of public use more than two years before application filed.....	2

Of the cases in which patents were held void as anticipated, Mr. Justice Roberts wrote three of the Court's opinions and Chief Justice Stone three. Of the patents held void for want of invention as distinguished from mechanical skill, Mr. Justice Roberts wrote two opinions, Chief Justice Stone one, Mr. Justice Butler one, Mr. Justice McReynolds one, and Mr. Justice Douglas one. Of the patents held void because of aggregation (and we distinguish this from the question of resolving the difference between invention and mechanical skill) Mr. Justice Roberts wrote one and Mr. Justice Butler one.

The following were the six cases in which patents were held void because of anticipation:

1. *Electric Cable Joint Co. v. Brooklyn Edison Co.*, 292 U. S. 69; April 2, 1934; Justice Stone. The patent was on a protective device for a cable joint. It was held invalid in that it was anticipated by the prior art and described in printed publications. It was further said that it was an old method to produce an old result.

2. *Keystone Driller Co. v. Northwestern Engineering Corp.*, 294 U. S. 42; January 7, 1935; Justice Roberts. One patent was held not infringed. A second patent was held

void for want of novelty. The third patent in suit was held void on the grounds of aggregation and is listed in that category.

3. *Paramount Publix Corp. v. American Tri Ergon Corp.*, 294 U. S. 464; March 4, 1935; Justice Stone. There was involved a patent on the method of producing sound and photographic film for synchronous reproduction. The method of the patent was—(1) to simultaneously expose sound and picture on separate films, this was old; (2) to develop the negative separately; this was old; (3) to print simultaneously on positive film; this was old in respect to two negatives of a picture. HELD, the process did not possess novelty; it was an old process adapted to a new and closely analogous use. *Brown v. Piper*, 91 U. S. 37, was relied upon for authority.

4. *Smith v. Hall*, 301 U. S. 216; April 26, 1937; Justice Stone. The Smith patent previously held valid in *Smith v. Snow*, 294 U. S. 1, was held invalid as anticipated.

5. *Textile Machine Works v. Hirsch Textile Machines*, 302 U. S. 490; January 3, 1938; Justice Stone. The patent involved was for an attachment for knitting machines; the patent was held invalid as “plainly foreshadowed, if not completely anticipated”.

6. *Detrola Radio v. Television Corp.*, 313 U. S. 259; May 12, 1941; Justice Roberts. The patent was on automatic control of radio amplification. It was held invalid for want of invention, if there was any advance over the art; but the Court said the Heising patent was an anticipation, though designed for a different purpose.

In the cases decided on issues other than the issue of invention we find no expression that varies the result of the examination of the cases in which the issue of invention was the determining one.